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PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JONG-SEO CHOI *et al.*

Serial No.: 09/964,375

Examiner: QUARTERMAN, KEVIN J.

Filed: 28 September 2001

Art Unit: 2879

For: CATHODE FOR ELECTRON TUBE HAVING NEEDLE-SHAPED
CONDUCTIVE MATERIAL AND METHOD OF PREPARING THE
CATHODE (as amended)

Paper No. 13

PETITION UNDER 37 CFR §1.144 AND §1.181
TO WITHDRAW A RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition under 37 CFR §1.144 and §1.181 to withdraw a restriction requirement set forth in the fourth Office Actions (Paper No. 1204) mailed 11 January 2005, whereby claims 36 thru 47 and 78 were finally withdrawn from consideration.

Applicants believe that no fee is required by this Petition. Should it be deemed that a fee is required for filing this petition, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicants' undersigned attorney in the amount of such incurred fees, if any, for this petition.

Folio: P55134
Date: 2/11/05
I.D.: REB/JGS/kf

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P58533**STATEMENT OF FACTS**

1. In an Amendment filed on the 2nd of September 2003, application newly presented, *inter alia*, claims 35 through 47 and 78.
2. In paragraphs 2 through 6 of a subsequently issued Office action, Paper No. 1103, the Examiner imposed a restriction and withdrew from consideration previously added claims 35 through 47, and parent independent claim 78.
3. In Paper No. 1103, the Examiner argued that claims 35 through 47 and 78 were related to the other pending claims "as process of making and product made."
4. In Paper No. 1103, the Examiner asserted that the inventions defined by claims 35 through 47 and 78 are distinct from the other pending claims because "the product as claimed can be made by another and materially different process" as contemplated by §806.05(f) of the *Manual of Patent Examining Procedure*.
5. In Paper No. 1103, the Examiner asserted that "in the instant case the cathode for an electron tube can be made by preparing a carbonate paste containing needle-shaped conductive material, coating the carbonate paste onto a metal base, and then calcining to form an electron-emitting layer."
6. In Paper No. 1204, an *Ex parte Quayle* action dated on the 11th of January 2005, the Examiner allowed all pending claims but claims 36 through 47 and 78, identified claims 36 through 47 and 78 as "non-elected with traverse", and required Applicant to cancel claims 36 through 47 and 78.

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ARGUMENT AND/OR REMARKS

In response to the Restriction Requirement, Applicant respectfully traverses the Restriction Requirement and requests reconsideration and withdrawal of the Restriction Requirement and examination of the withdrawn claims 36 through 47 and 78.

In paragraphs 2 through 6 of the Office action (Paper No. 1103), the Examiner imposed a restriction and withdrew from consideration previously added claims 35 through 47 (the Examiner's attention is invited to the dependency of claims 36 through 47 upon newly presented claim 78) from consideration as allegedly being directed to a non-elected invention. Subsequently, in Paper No. 1204, an *Ex parte Quayle* action dated on the 11th of January 2005, the Examiner allowed all pending claims but claims 36 through 47 and 78.

First, the Examiner's imposition of a requirement for restriction, ostensibly under 37 CFR §1.141, is improper. The instant claims of the instant "application define the same essential characteristics of a *single* disclosed embodiment of an invention", even though those claims are very broadly written to encompass various and diverse implementations of that embodiment. Under current Office practice,

"[w]here the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should *never* be required."¹

Accordingly, the Examiner's withdrawal of claims 36 through 47 and 78 from examination is contrary to the requirements set forth in the *Manual*, and should not be sustained.

Second, the Examiner's withdrawal of claims 36 through 47 and 78 from examination is precipitous. Under 37 CFR §1.142, should the Examiner properly determine that,

¹ *Manual of Patent Examining Procedure*, §806.03 (8th Ed., Rev. 2, May 2004).

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“two or more independent *and* distinct inventions are claimed in a single application, the Examiner in an Office will require *the applicant* in the reply to that action to elect an invention to which the claims will be restricted ...”²

Here, the Examiner cited 37 CFR §1.142(b) and summarily first withdrew claims 35 through 47 from consideration in Paper No. 1103, and subsequently in Paper No. 0504, withdrew independent parent claim 78 from consideration.³ The precipitous denial of this right to make an election may not be sustained.

Third, the Examiner’s withdrawal of claims 36 through 47 and 78 from examination is was based upon an incomplete consideration under 37 CFR §1.142, which states that when the Examiner properly determines that,

“two or more independent *and* distinct inventions are claimed in a single application, the Examiner in an Office will require *the applicant* in the reply to that action to elect an invention to which the claims will be restricted ...”⁴

Here, the Examiner in Paper No. 1103, (i) asserted that the inventions defined by claims 35 through 47 and 78 are distinct from the other pending claims because “the product as claimed can be made by another and materially different process” as contemplated by §806.05(f) of the *Manual of Patent Examining Procedure*, and (ii) then purported to demonstrate that the “inventions defined by claims 35 through 47 and 78 are distinct” by arguing that,

“in the instant case the cathode for an electron tube can be made by preparing a carbonate paste containing needle-shaped

² 37 CFR §1.142(a) grants to the Applicant, rather than to the Examiner, a right “to elect an invention to which the claims will be restricted.”

³ Nothing in 37 CFR §1.142(b) contravenes the grant of the right given to the Applicant by 37 CFR §1.142(a) “to elect an invention to which the claims will be restricted.”

⁴ 37 CFR §1.142(a) grants to the Applicant, rather than to the Examiner, a right “to elect an invention to which the claims will be restricted.”

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conductive material, coating the carbonate paste onto a metal base, and then calcining to form an electron-emitting layer.”⁵

Paper No. 1103 ignored the requirement of 37 CFR §1.142(a) that prior to imposition of a requirement for restriction, the Examiner first find that “two or more independent *and* distinct inventions are claimed in a single application.” Paper No. 1103 makes not pretense of a finding of the existence of *independent* inventions; in fact, Paper No. 1103 admits that the subject matter of the claims examined and those withdrawn from consideration are in the opinion of the Examiner, in fact “*related* as process of making and product made.” Given this admission by the Examiner, the subsequent failure to comply with the dictate of 37 CFR §1.142 and the guidance of *Manual of Patent Examining Procedure*, §806.03 (8th Ed., Rev. 2, May 2004) is inexcusable, and unfairly denies to Applicant the scope of coverage to which the Applicant is entitled.⁶ Consequently, the withdrawal of claims 35 through 47 and 78 from examination is improper, and should not be sustained.

Fourth, Applicant previously noted that the restriction requirement imposed by the Examiner in paragraphs 2-6 of the Office action, was imposed solely on the grounds that the restriction requirement is being imposed merely for the administrative convenience of the U.S. Patent & Trademark Office. It should be noted that, previously, the Commissioner of Patents

⁵ Examiner’s Comments, Paper No. 1103.

⁶ The *Manual of Patent Examining Procedure*, §806.03 (8th Ed., Rev. 2, May 2004) approvingly contemplates the presence of claims of different scope and statutory classes within a single application, by explaining that “[w]here the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction should never be required ... because the claims are but different definitions of the same disclosed subject matter, varying in breath or scope of definition.”

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and Trademarks stated that mere administrative convenience is not a proper basis for imposition of a restriction requirement. On the latter basis, it is respectfully requested that the restriction requirement imposed in the previous Office action be withdrawn, and that claims 36 through 47 and 75 be examined in this application.

Fifth, claims 36 through 47 and 78 contain common subject matter; consequently the mandatory field of device and manufacture search are co-extensive. There is, therefore, no basis under 37 CFR §1.141 to justify maintaining the restriction. Its withdrawal, and examination of claim 75, are requested.

Sixth, the elected claims define a structure; under the first paragraph of 35 U.S.C. §112, each patent reference within the field of mandatory search for the elected claims must describe how to "make and use" the structure disclosed. Consequently, the mandatory field of search for the structure defined by the elected claims is necessarily concurrent with the field of search of claim 78. Withdrawal of the restriction and examination of claim 78, together with its dependent claims, is respectfully requested.

RELIEF REQUESTED

In view of the foregoing, the Commissioner is respectfully requested to:

- A. Withdraw the restriction requirement set forth in the Office action mailed on 11 January 2005 (Paper No. 1204);
- B. Return this application to the Examiner for consideration of claims 36 through 47 and 78; and
- C. Grant Applicant such other and further relief as justice may require.

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No fee is believed to have been incurred by this Petition. Should any fee be incurred however, the Commissioner is authorized to charge Deposit Account No. 02-4349 of Applicant's undersigned attorney, and is requested to then notify the undersigned attorney of the charge.

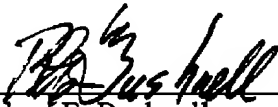
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Respectfully submitted,


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